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No. 96-1556

In the Supreme Court of the United States

OCTOBER TERM, 1996

STEVEN G. LOUGH, PETITIONER

v.

BRUNSWICK CORPORATION
D/B/A MERCURY MARINE, RESPONDENT

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether the Federal Circuit correctly held, based on undisputed facts, that petitioner's patent was invalid because the invention had been in "public use" within the meaning of 35 U.S.C. § 102(b).

RULE 29.6 STATEMENT

Respondent Brunswick Corporation has a minority interest in Tracker Marine L.P.

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BRIEF FOR THE RESPONDENT IN OPPOSITION

Stripped of its rhetoric, the petition asks this Court to reexamine the Federal Circuit's conclusion that, on the undisputed facts of this case, petitioner's patent was invalid because the invention had been in "public use," within the meaning of 35 U.S.C. § 102(b). There is no reason for further review of this routine dispute over the application of settled law to a unique set of facts.

STATEMENT

The patent laws place strict limits on the inventions that may be accorded patent protection. For example, "[a] patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Even an invention that is not obvious in light of prior art may be unpatentable because the inventor "has abandoned the invention" (*id.* § 102(c)), or because the invention was "on sale * * * more than one year prior to the date of the application for patent" (*id.* § 102(b)), or because the invention was "in public use" more than one year before the patent application was filed (*ibid.*). "The inventor must comply with the conditions prescribed by law. If he fails to do this he acquires no title * * * ." *Consolidated Fruit-Jar* Co. v. *Wright*, 94 U.S. 92, 96-97 (1876).

The statutory bar for inventions in "public use" has been construed by this Court to exclude uses "by the inventor himself, or any other person under his direction, by way of experiment, and in order to bring the invention to perfection." *Elizabeth* v. *Pavement Co.*, 97 U.S. 127, 134 (1877). This case turns on the application of the public use bar in light of a claim that the *prima facie* public use was experimental.

A. Factual Background

1. Respondent Brunswick Corporation, through its Mercury Marine division, manufactures outboard boat engines and inboard/outboard boat propulsion systems, also known as stern drives. In these drives, a gearshift-shaft runs upward from a lower gear box, which is generally adjacent to the propeller under the water line. See Pet. App. 3-4. For decades, Brunswick and its predecessor in interest have developed and produced bushing and annular seal assemblies for the shafts of the drive-shifts on its stern drives and outboards. C.A. App. 626, 1165, 4001, 4135. The lower seal assembly on the stern drives kept seawater and engine exhaust from contacting the gear assembly at the lower end of the shift-shaft, while the upper seal assembly sealed the housing containing a gear-shift cable that led to the user controls for gear selection. See Pet. App. 3-4. The lower seal assembly, which itself had been sold for decades, used a bushing that fit snugly against the shift-shaft at the lower end but, where it contacted the water, formed a wider cylinder that insulated the annular seal from the housing. See C.A. App. 4001, 4135. Brunswick used a similar assembly (incorporating two annular seals) on its outboard engines for decades as well. See *id.* at 4002.

2. In April 1986, petitioner Steven Lough began working for Marine Service, a boat dealership in Sarasota, Florida. Lough repaired Brunswick inboard/outboard propulsion systems and became acquainted with seal assemblies on their shift-shafts. Pet. App. 4; C.A. App. 310, 323.

In the Brunswick upper seal assembly, the seal was in direct contact with the aluminum housing that held the bushing and seal. Pet. App. 5. The upper seal assemblies tended to corrode in the highly saline Sarasota waters. *Id.* at 4; C.A. App. 1357. In the spring of 1986, Lough fashioned an upper seal assembly that, he hoped, might be more resistant to corrosion. Pet. App. 4-6, 15. Like the Brunswick lower seal assembly, Lough's assembly had a bushing that fit snugly

around the shift-shaft at the dry end but widened to hold the seals at the end that might be exposed to water, separating the seals from the aluminum bell housing that held the bushing. See C.A. App. 4001, 4135. Like Brunswick's outboard seal assemblies, Lough's assembly used two seals within the bushing that separated the seals from the housing. See *id.* at 4002.

3. Lough placed one of his seal assemblies in his own boat and, after testing it in the water for about three months, "he determined that it worked." Pet. App. 15. In the summer of 1986 he gave five additional assemblies to friends and acquaintances, including the co-owner of Marine Service and a Marine Service customer. *Id.* at 15-16. (Lough conceded that his invention had been reduced to practice by August 1, 1986. C.A. App. 4020-4021, 292-294.)

Lough provided two of the seal assemblies to friends who worked at Gulfwind Marine, another Sarasota marina, telling his friends that "he wanted to sell [the] seal assemblies" to Gulfwind. C.A. App. 1355; Pet. App. 5, 15. His free-trial marketing succeeded. After the assemblies had been installed, Gulfwind Marine "wanted to buy more" seal assemblies from Lough and asked him about future sales. C.A. App. 287.

When he distributed his seal assemblies, Lough did not place any restriction on their use, and he did not ask the recipients (much less the boat owners whom he did not know) to keep his invention secret. Pet. App. 17, 19; C.A. App. 286. One Gulfwind Marine assembly was installed in the boat of Mark Liberman, a local charter guide. Pet. App. 16. The other was installed in a "demonstration boat" that subsequently "was sold." *Ibid.* No one knew what happened to the demonstration boat or the seal assembly it contained. *Ibid.*

Moreover, Lough gave away his seal assemblies without making "any provision for follow-up involvement by him in assessment of the events occurring during the alleged experiments." Pet. App. 17. Indeed, Lough did not know in which boats the Gulfwind Marine assemblies were installed; he was

not present during their installation; and he never inspected them afterward. *Ibid.*; C.A. App. 283-285. He did not monitor the test uses of his seal assemblies by his friends and acquaintances at Gulfwind Marine (much less by the people he did not know), and he did not record any performance results or feedback of any kind. Pet. App. 19. In fact, "[f]or over a year following the installation of these prototypes, Lough neither asked for nor received any comments about the[ir] operability." *Id.* at 5; see *id.* at 16. Receiving comments would have been difficult, since Liberman did not know that Lough's seal assembly had been installed in his boat (C.A. App. 1499), and Lough did not know who owned the "demonstration boat."

In reality, the "testing" of each seal assembly at Gulfwind Marine consisted of "install[ing] it and let[ting] it go." C.A. App. 1356. Lough "figured no news was good news." *Id.* at 285.

4. Lough filed a patent application for his seal assembly on June 6, 1988, about two years after he had distributed the prototype assemblies in the two marinas. Pet. App. 5. In prosecuting the patent, Lough did not disclose the similar seal that Brunswick routinely installed on the lower end of its drive shafts, and he did not disclose that he had distributed the seals for installation on others' boats in 1986. See C.A. App. 6-7. The patent was issued on July 18, 1989. Pet. App. 5.

B. Proceedings Below

1. After Brunswick developed its own improved upper seal assembly, Lough sued Brunswick for infringement of his patent. Pet. App. 9. Brunswick contended that the patent was unenforceable due to inequitable conduct because Lough had not disclosed to the Patent and Trademark Office either the prior uses of his seal assemblies or the prior art in the Brunswick seal assemblies. C.A. App. 119-134. Brunswick also claimed that Lough's patent was invalid because the invention was obvious in light of prior art and the invention

had gone into public use when Lough distributed the assemblies in 1986. *Id.* at 56-58.

Lough did not dispute that he had distributed five seal assemblies to others for their use more than a year before he filed his patent application. Pet. App. 12. The district court instructed the jury that the "only dispute" on the public use question was "whether these uses qualify as experimental uses," and that Lough had "the burden * * * to come forward with convincing evidence showing that these were experimental uses." *Id.* at 12-13 n.4.[1] The court rejected Brunswick's inequitable conduct defense; it also submitted the issue of claim construction to the jury, over Brunswick's objections and contrary to the later-decided case of *Markman* v. *Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996). See C.A. App. 2, 5-8, 1665-1666.

The jury found that Lough's patent was valid and infringed (but not willfully infringed), awarding $1.5 million in damages for lost profits. Pet. App. 9. The jury specifically found that Brunswick had not proved "that any one of the seal assemblies distributed by Mr. Lough w[as] in public use more than one year before the filing of his patent application." C.A. App. 1.

3. After its post-trial motions were denied, Brunswick appealed to the Federal Circuit. In defending the jury's public use finding, Lough did not assert that the ultimate determination whether a use was public or experimental was entirely factual. Rather, he told the court of appeals that it should review the jury's resolution of factual disputes for substantial evidence, but should review *de novo* "any conclusion respecting an issue of law based on the facts which are supported by

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[1] Lough did not preserve his belated objection to the allocation of burdens on this issue. See Pet. 17. He agreed below that "[o]nce the challenger has made out this *prima facie* case of public use, a burden of production is placed upon the patent owner who must come forward with convincing evidence to counter the *prima facie* case." Lough C.A. Br. 34.

substantial evidence." Lough C.A. Br. 34. The court agreed. Pet. App. 10.

The Federal Circuit reversed the judgment on the ground that the seal assemblies had been in public use. Pet. App. 1-21. The court of appeals treated "the jury's verdict on the legal issue as a resolution of all genuinely disputed underlying factual issues in favor of the verdict winner." *Id.* at 10. But, taking the facts that "either were undisputed or were as asserted by Lough" (*id.* at 16), the court held that "the jury had no legal basis to conclude that the uses of Lough's prototypes were experimental and that the prototypes were not in public use prior to the critical date" (*id.* at 18). In particular, the court concluded that "Lough's failure to monitor the use of his prototypes by his acquaintances, in addition to the lack of records or reports from those acquaintances concerning the operability of the devices, compel the conclusion that, as a matter of law, he did not engage in experimental use." *Id.* at 19. Rather, Lough had "distribute[d] his invention to members of the public under circumstances that evidence a near total disregard for supervision and control concerning its use"; his failure to present evidence of even the "minimal indicia of experimentation" compelled "a conclusion that the invention was in public use." *Ibid.*

Judge Plager dissented. He agreed that the "ultimate question of what is public use" is "a question of law," but maintained that whether "the challenged use was experimental" was a mixed question of law and fact. Pet. App. 24. In Judge Plager's view, "there was more than enough evidence to support a jury finding" that Lough's distribution of his seal assemblies was experimental. *Id.* at 25.

In his rehearing petition (at 6-9), Lough argued that the court of appeals had misapplied the standard for judgment as a matter of law and had erroneously assigned him the burden of proving that his uses were not public uses. He also contended (Reh'g Pet. 9-15) that the court had misapprehended or

overlooked facts that supported the judgment. But he did not maintain that either the ultimate determination of public use or the issue of experimental use should be treated as a standardless question of fact.

Rehearing and rehearing en banc were denied. Three judges dissented from the denial of rehearing en banc, maintaining that the panel had inappropriately treated public use under Section 102(b) as a question of law. Pet. App. 37-55, 62-87. A fourth judge—Judge Michel—did not agree that "public use should be reclassified as an issue of fact," but also dissented because he believed that the en banc court should conclusively "identify" which "indicia of 'control'" must be proved in order to "avoid the public use bar." *Id.* at 56-57.

ARGUMENT

This case does not warrant further review. Contrary to Lough's assertion (Pet. 2), the Federal Circuit did *not* "remove[] the issue of patent invalidity due to public use from the jury as a trier of facts." Rather, the court of appeals simply applied this Court's established standards to conclude, as a matter of law, that Lough's distribution of his invention was not experimental because he did not supervise, monitor, or control the uses of his invention. Pet. App. 16-19. In reaching this unexceptional conclusion, the court below expressly relied on facts that "were either undisputed or were as asserted by Lough." *Id.* at 16.

Accordingly, this case presents no broad and unresolved questions of the allocation of issues between judge and jury. The ultimate determination whether a pre-filing use of an invention was an invalidating "public use" within the meaning of 35 U.S.C. § 102(b), or whether, despite the *prima facie* showing of public use, the use was experimental and therefore excluded from the statutory bar, is a question of patent validity—that is, of patentability—and thus is a question of law. *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966). There is no merit to Lough's suggestion, made for the first time in this

Court, that whether a use is public or experimental is a purely factual determination that cannot be overturned. In fact, this Court repeatedly has overturned the judgments of factfinders on public use and experimental use alike, not as clearly erroneous findings of fact, but as misapplications of law.

Finally, there is no conflict among the circuits on this issue of patent law. As this Court only recently remarked, the question of how "to promote certainty, consistency, and reviewability" in patent law is best "le[ft] to the Federal Circuit." *Warner-Jenkinson Co.* v. *Hilton Davis Chemical Co.*, 117 S. Ct. 1040, 1053 n.8 (1997).

A. The Federal Circuit Correctly Applied The Standard For Granting Judgment As A Matter Of Law To The Question of Public Use

1. Echoing every party that has lost on summary judgment or judgment as a matter of law, Lough claims that the Federal Circuit "has removed the issue of patent invalidity due to public use from the jury as trier of facts." Pet. 2. But that misdescribes this case. The *holding* below was merely that "the jury had no *legal* basis to conclude that the uses of Lough's prototypes were experimental and that the prototypes were not in public use prior to the critical date." Pet. App. 18 (emphasis added).

The Federal Circuit explicitly acknowledged that it was for the jury to decide the underlying facts necessary to resolve the ultimate question of law. Pet. App. 10. In some circumstances a jury's determination of a dispositive (and disputed) historical fact may govern the question of public use, but that is not always the case. As with any other issue determined by a jury, including "a mixed question of law and fact," judgment as a matter of law "is mandated where the facts and the law will reasonably support only one conclusion." *Harbor Tug & Barge Co.* v. *Papai*, No. 95-1621, slip op. 5 (U.S. May 12, 1997); see *Warner-Jenkinson*, 117 S. Ct. at 1053 n.8; *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*,

340 U.S. 147, 153-154 (1951) (reversing judgment of validity where relevant legal standard was applied to the facts in a manner "less exacting than that required"); *Bose Corp.* v. *Consumers Union*, 466 U.S. 485, 501 & n.17 (1984); Fed. R. Civ. P. 50(a)(1).[2]

Indeed, this Court *sua sponte* held a patent barred by public use even though the issue had not been presented in the lower courts, because "[t]o sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the patent statutes." *Muncie Gear Works, Inc.* v. *Outboard Marine & Mfg. Co.*, 315 U.S. 759, 768 (1942) (Jackson, J.). This Court also has disagreed with factfinders on the question whether stated facts make out an experimental or a public use. The first decision of this Court to negate public use as experimental reversed the public use determination of the trial court. *Elizabeth*, 97 U.S. 127. And this Court held another patent barred by public use as a matter of law, despite the factfinder's contrary determination, because the proof fell "far short of establishing" that the uses were experimental. *Smith & Griggs Mfg. Co.* v. *Sprague*, 123 U.S. 249, 266 (1887).

The Federal Circuit is well equipped to define the measure of proof of experimental use that is required to negate the public use bar. In establishing standards for *de novo* review of the ultimate determination of public use, the Federal Circuit continues to "promote certainty, consistency, and reviewability" by clarifying the governing principles of patent law, just as this Court said it should. See *Warner-Jenkinson*, 117 S. Ct. at 1053 n.8. See also *Ornelas* v. *United States*, 116 S. Ct. 1657, 1662 (1996) (*de novo* review of

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[2] Lough's inaccurate representation of the evidence in this case may signal his disagreement with the Federal Circuit's apprehension of the undisputed facts, but such factual disputes plainly do not warrant review. *NLRB* v. *Hendricks County Rural Electric Membership Corp.*, 454 U.S. 170, 176 n.8 (1981); *Rudolph* v. *United States*, 370 U.S. 269, 270 (1962) (per curiam).

determinations of probable cause and reasonable suspicion—mixed issues of fact and law that determine bars to criminal evidence rather than patentability—is "necessary if appellate courts are * * * to clarify the legal principles").[3]

It was, of course, "just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court[] for patent cases." *Markman*, 116 S. Ct. at 1396. See 28 U.S.C. § 1295(a).[4] Because there can be no conflict among the circuits on the interpretation of the statutory public use bar or the judge-made allowance for experimental use, Lough spends considerable energy (Pet. 14-19) in an attempt to demonstrate a conflict within the Federal Circuit. But even if there were some unevenness in the exposition of public or experimental use within the Federal Circuit, intra-circuit conflicts are not this Court's concern. "It is primarily the task of a Court of Appeals to reconcile its internal difficulties," *Wisniewski* v. *United States*, 353 U.S. 901, 902 (1957); here, a substantial majority of the Federal Circuit found no question warranting *en banc* review.

B. The Application Of The Term "Public Use" In 35 U.S.C. § 102(b) To Particular Facts Is A Question Of Law

1. Lough insists that "[t]his Court has consistently held that what constitutes [a] public use is a question of fact." Pet.

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[3] By contrast, the law of public use would be "completely unpredictable" (Pet. 18) if, as Lough suggests, the courts treated public use as a standardless, purely factual question, and made experimental use an unreviewable matter of a jury's perception of the inventor's subjective intent.

[4] For this reason, and because the Federal Circuit also succeeded to the appellate jurisdiction of the Court of Customs and Patent Appeals and the Court of Claims, there is no merit to Lough's attempt (Pet. 13 n.1) to manufacture a conflict among the circuits based on decisions that antedate the creation of the Federal Circuit.

12. However, Lough did not present this claim to either court below, and he therefore has waived it. See, *e.g.*, *Sisson* v. *Ruby*, 497 U.S. 358, 359 n.1 (1990); *Delta Airlines* v. *August*, 450 U.S. 346, 362 (1981).

In any event, the contention is unfounded. The very passage that Lough cites (Pet. 12) contradicts him. In *Pennock* v. *Dialogue*, this Court readily acknowledged that "when all the facts are given, there does not seem any reason why the court may not state the *legal conclusion* deducible from them." 27 U.S. (2 Pet.) 1, 15 (1829) (emphasis added). That is exactly what the Federal Circuit did here.

Indeed, this Court first applied the experimental-use exception by determining whether, on the evidence, a use was "a public use, within the meaning of the law." *Elizabeth*, 97 U.S. at 134. And in rejecting a claim that giving an invention to one friend could be an experimental use without supporting indicia of control and testing, the Court again determined "whether [given] testimony shows a public use within the meaning of the statute." *Egbert* v. *Lippmann*, 104 U.S. 333, 336 (1881).

2. There is another reason why the ultimate determination of public use or experimental use is a question of law. Whether a use is public or experimental determines the validity of a patent; it is settled that the ultimate question of patent validity is a question of law. *Sakraida* v. *Ag Pro, Inc.*, 425 U.S., 273, 280 (1976); *Graham*, 383 U.S. at 17. Resolving patent validity in this way, as otherwise, requires not only "basic factual inquiries" (*Graham*, 383 U.S. at 17), but also consideration and analysis of the policies of the patent laws and their constitutional underpinnings. See *id.* at 6.

Moreover, because the legal rules for "public use" and "experimental use" can acquire meaning only through application, independent appellate review is "necessary if appellate courts are to maintain control of, and to clarify[,] legal principles." *Ornelas*, 116 S. Ct. at 1662. In similar situations,

where "the relevant legal principle can be given meaning only through its application to the particular circumstances of a case," this Court "has been reluctant to give the trier of fact's conclusions presumptive force and, in so doing, strip a federal appellate court of its primary function as an expositor of law." *Miller* v. *Fenton*, 474 U.S. 104, 114 (1985). The decision below accords with these principles.

Lough argues that the determination of experimental use is a factual question because it involves an examination of the totality of circumstances in light of the "policies underlying the public use bar." Pet. App. 18-20. The consideration of the "policies underlying" a federal statute is quintessentially a matter of law and a duty for the court. See, *e.g.*, *Graham*, 383 U.S. at 5-6, 17-18. Courts regularly determine whether the totality of the circumstances falls within statutory or constitutional terms, and review of those determinations is characteristically *de novo*. See, *e.g.*, *Community for Creative Non-Violence* v. *Reid*, 490 U.S. 730, 752 (1989) (whether the totality of the circumstances showed that an artist was an "employee" and his work therefore a "work made for hire" under the Copyright Act); *Ornelas*, 116 S. Ct. at 1661-1663 (whether the totality of the circumstances provided reasonable suspicion or probable cause under the Fourth Amendment).

3. Lough identifies (Pet. 12-13) several decisions of this Court that acknowledge that evidence and factual findings are important in the legal determination of public or experimental use. That "proof of prior use" in a case "depends on the testimony" (*Cantrell* v. *Wallick*, 117 U.S. 689, 696 (1886)) is an accurate description, not a legal rule; "proof" generally depends on evidence. But none of the cited cases treats the public use bar as a question committed to the unreviewable discretion of the factfinder. And Lough can derive little help from this Court's frequent agreement with two lower courts' findings of dispositive historical facts. *E.g.*, *General Talking Pictures Corp.* v. *Western Electric Corp.*, 304 U.S. 175, 182-183 (1938). But see *Great A&P*, 340 U.S. at 153-154 (two-

court rule not controlling where lower courts applied erroneous legal standard to undisputed facts).

In any event, this case presents no issues of historical fact that are both contested and material. Lough does not identify a single material historical fact that he contends was erroneously stated by the court of appeals. And, for all his factual argument, Lough does not support a single assertion—and many are insupportable—with a citation to the record. The legal effect of undisputed facts is a question for the courts.

C. The Federal Circuit Correctly Held That Petitioner's Unrestricted Distribution Of His Invention Was A Public Rather Than An Experimental Use

At bottom, Lough contends simply that the Federal Circuit erred in concluding that, on these facts, the distribution of his invention was a public rather than an experimental use. The Federal Circuit's emphasis on supervision, control, and feedback, however, accords with settled law on the questions of public and experimental use. In holding that Lough's uses of his invention were invalidating public uses as a matter of law, the court of appeals stressed that the extent of the inventor's control over the testing "is critically important, because, if the inventor has no control over the alleged experiments, he is not experimenting. If he does not inquire about the testing or receive reports concerning the results, similarly, he is not experimenting." Pet. App. 14. Lough has offered no coherent rationale to rebut these common-sense observations, which fall well within the Federal Circuit's duty, in its "sound judgment in this area of its special expertise," to "refine the formulation" of legal tests for application by fact-finders "in the orderly course of case-by-case determinations." *Warner-Jenkinson*, 117 S. Ct. at 1054.

Lough would reduce experimental use to a standardless question of subjective intent, where persuasion of a jury could substitute for objective evidence. But the subjective intent of

the inventor is of minimal value in determining whether a use is experimental rather than public. Lough himself conceded this point below, Lough C.A. Br. 36, and with good reason. This Court overturned a factfinder's conclusion that a use was experimental where the judgment rested on the inventor's intent; the inventor's failure to give account of the particulars of those experiments rendered the use public. *Smith & Griggs*, 123 U.S. at 265. "Whatever may be the intention of the inventor, if he suffer his invention to go into public use, by any means whatever, without an immediate assertion of his right, he is not entitled to a patent." *Pennock*, 27 U.S. (2 Pet.) at 2 n.1. See also Rooklidge, *The On Sale and Public Use Bars to Patentability: The Policies Reexamined*, 1 FED. CIR. B.J. 7, 36 (1991) (citing Federal Circuit precedents).

Under the purely subjective evaluation that Lough proposes, the exception for experimentation would swallow the public use bar. To the contrary, however, this Court long has required an "experimenting" inventor to maintain control over his invention in order to negate the public-use bar:

> If an inventor, having made his device, gives * * * it to another, to be used by the donee * * * without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person.

Egbert, 104 U.S. at 336. That precisely describes Lough's distribution of his seal assemblies to Gulfwind Marine. Those distributions are enough; a single public use of an invention invalidates a patent, even if the use is by an "intimate friend" of the inventor and the invention is concealed from public view. *Id.* at 335-336 (hook for Victorian-era lady's corset).

In this Court's first application of the experimental-use doctrine, the determining factor was that the inventor "did not let [his invention] go beyond his control." *Elizabeth*, 97 U.S. at 136. The Court distinguished between use that occurs

> under the surveillance of the inventor, and for the purpose of enabling him to test the machine, and ascertain whether it will answer the purpose intended, and make such alterations and improvements as experience demonstrates to be necessary,

id. at 135, and use "by other persons generally." *Ibid.* In *Elizabeth*, the inventor built a short stretch of prototype pavement on a toll road in which he was a shareholder. *Id.* at 133. Unlike Lough, the inventor in *Elizabeth* inspected his invention "almost daily[,] * * * making particular examination of its condition." *Ibid.* Had the patentee "allow[ed] others to use" his invention "by laying down the pavement in other streets and places," however—had he "let it go beyond his control"—the patent would have been invalid. *Id.* at 136.

This emphasis on regular inspections and control of the invention is confirmed—and compelled—by the very cases on which Lough relies (Pet. 13-14). This Court held that public use was established by the inventor's allowing two relatives "the unrestricted use" of the invention "without injunction of secrecy or other condition." *Manning* v. *Cape Ann Isinglass & Glue Co.*, 108 U.S. 462, 465 (1883). In another case, the use of an invention was public and not experimental because the inventor did not "reserv[e] any future control over it" and "never made an examination with a view of seeing whether it was defective." *Root* v. *Third Ave. R.R.*, 146 U.S. 210, 221 (1892). In a third case, this Court held a patent invalid where the inventor had "utter[ly] neglect[ed] * * * the model." *Consolidated Fruit-Jar,* 94 U.S. at 95. Other decisions are to the same effect. See *Electric Storage Battery Co.* v. *Shimadzu*, 307 U.S. 5, 20 (1939) (public use based on use of inventions without any effort "to conceal them from anyone who had a legitimate interest in understanding them"); *International Tooth-Crown Co.* v. *Gaylord*, 140 U.S. 55, 64 (1891) (reject-

ing experimental use where inventor revealed his invention to other dentists without restriction).[5]

The leading commentator agrees that "the absence of [regular] inspections virtually precludes a finding of experimental purpose," and that "[r]etention of control over the invention by the inventor" likewise "is ordinarily essential to a finding of experimental use." 2 CHISUM ON PATENTS § 6.02(7), at 6–123 to 6–124 (1997). See also Rooklidge, *supra*, 1 FED. CIR. B.J. at 37 ("In order to invoke experimental use, * * * the inventor must keep the invention under his own control.").

In short, there is nothing remarkable about the rule of law applied below, or the way in which the Federal Circuit applied it. And this case is a poor vehicle even if a worthy issue were presented, because the judgment of infringement could not stand after *Markman* and *Warner-Jenkinson*. Further review therefore is not warranted.[6]

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[5] See also *Kock* v. *Quaker Oats Co.*, 681 F.2d 649, 658 (9th Cir. 1982) (Kennedy, J.) ("experimental use" exception to on-sale bar did not apply without any "enforceable obligation on the buyer to hold the invention or design for experimental purpose only"), cert. denied, 459 U.S. 1147 (1983).

[6] Lough attempts (Pet. 21-22) to link his petition to a case presenting a different issue, *i.e.*, whether (as both the majority and dissent in that case agreed) invalidity based on the "on sale" bar of 35 U.S.C. § 102(b) is a question of law. See *Micro Chemical, Inc.* v. *Great Plains Chemical Co.*, 103 F.3d 1538, 1544 (Fed. Cir. 1997); *id.* at 1551 (Mayer, J., dissenting). Whatever the merits of any petition that may be filed in *Micro Chemical* despite its interlocutory posture, that case cannot by osmosis make this one warrant review. And even the *dissent* in *Micro Chemical* offers Lough little succor, because it criticized the majority for relying on "secret, subjective, and self-interested beliefs of an inventor"—precisely what Lough advocates for public use questions.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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